IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICANT(s): | Salgado et al. | CONF. NO.: | 5473 |
| SERIAL NO.: | 09/448,804 | ART UNIT: | 2164 |
| FILING DATE: | 11/24/1999 | EXAMINER: | Pannala, Sathyanarayan R |
| TITLE: | METHOD AND APPARATUS FOR MANAGING SOFTWARE... | | |
| ATTORNEY DOCKET NO.: | 690-008859-US (PAR)<br>D/99253 | | |

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COMMISSIONER FOR PATENTS

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**REQUEST FOR PRE-APPEAL BRIEF CONFERENCE REVIEW**

This request is being filed together with a Notice of Appeal. A prior Notice of Appeal was filed on March 28, 2006, and no new fee should be due.

In the Office Action mailed July 26, 2007, claims 12-14 are rejected under 35 U.S.C. §101 "because none of the claims are directed to statutory subject matter." In the Advisory Action mailed October 11, 2007, the Examiner states that "there is no physical device like a processor and a storage" incorporated in claims 12-14. It is respectfully submitted that this is incorrect and the rejection is erroneous.

Claim 12 is directed to a software copyright information managing system. Claim 12 explicitly recites "a system controller," a "user interface," and a "memory." It is submitted that each of these claimed elements is sufficient to comprise the necessary physical articles or objects to constitute a machine or manufacture within the meaning of 35 U.S.C. §101. A "system controller," "user interface," and "memory" are not

functional descriptive material as suggested by the Examiner. These recited claim features are also not abstract ideas, natural phenomena or laws of nature. Thus, they are eligible for and are not excluded from patent protection.

Claim 13 also recites a "memory". A "memory" is a physical storage device. Thus, claim 13 is not merely "descriptive material" as suggested by the Examiner, and the claim is directed to statutory subject matter.

Claim 14 recites not only a "memory," but also that the "memory" is "non-volatile memory." Clearly, both "memory" and "non-volatile memory" are physical devices and fall into one of the categories of statutory subject matter.

Therefore, since each of claims 12, 13 and 14 recite physical devices, the claims are directed to statutory subject matter. The rejection of claims 12-14 under 35 U.S.C. §101 is erroneous and subject to correction.

Claims 1-21 are rejected under 35 U.S.C. §103(a) over the combination of Nakagawa (U.S. Patent Pub. 2003/0159065) in view of IBM Technical Disclosure Bulletin 12/1994 and Schwarz, Jr. (U.S. Patent No. 6,476,927). It is submitted that a prima facie case of obviousness cannot be established because Schwarz, Jr. is non-analogous art and there is no motivation to combine Schwarz, Jr. with the other references.

According to 35 U.S.C. §103(a), a reference is analogous art if:

1) The reference is in the same field of endeavor as the Applicant's, or

2) The reference is reasonably pertinent to the particular problem with which Applicant was concerned.

Applicant's claimed subject matter is directed to a system for collecting and publishing copyright data. Schwarz, Jr. is directed to "print job distribution" and a "job token printer assignment system" to control information flow and scheduling of "printed

documents." (Col. 1, lines 6-10). Scheduling the printing of documents is not in the same field as collecting and displaying copyright information.

Also, Applicant's claimed subject matter is directed to the problem of obtaining and verifying copyright data and information. Schwarz, Jr. is directed to a "print server print job token that minimizes network loads while providing central printer control and accounting information." (Col. 3, lines 56-60). This is not the same problem and is not related to collecting copyright data, as is addressed by Applicant.

Thus, Schwarz, Jr. is neither in the same field as Applicant, nor is it reasonably pertinent to the problem addressed by Applicant. As such, it is non-analogous art, and cannot properly be used for purposes of 35 U.S.C. §103(a).

Even if it could properly be combined with the other cited references, there is no motivation to do so. Motivation, for purposes of 35 U.S.C. §103(a), requires at least some reason to combine the references in the fashion claimed by Applicant. Here, the Examiner states that the motivation to combine is that "Schwarz's teachings would have allowed Nakagawa's method to minimize network loads, while providing central printer control." (OA mailed July 27, 2007, page 4, paragraph 6). This is confusing. Nakagawa is a copyright inspection apparatus. Figure 9 and Col. 6, lines 42-46 of Schwarz referenced by the Examiner, merely discusses the central printer server of Schwarz. There is no reason or explanation why Nakagawa would want or desire such a central print server. In fact, Nakagawa only mentions that the digital data may be output to a "printer." [0071]. Nakagawa does not mention any problem or need for such a central print server. In the lack of any apparent reason to combine the references in the fashion claimed by Applicant, it is submitted that there is no motivation to combine the references as proposed.

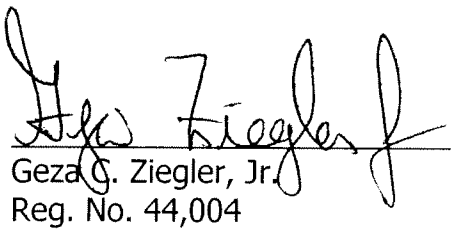
In any event, the combination of references does not disclose or suggest collecting copyright data as recited by Applicant in the claims. Therefore, each element recited in the claims is not taught by the combination of references.

Therefore, since Schwarz is non-analogous art, there is no motivation to combine references, and each element recited in the claims is not taught by the combination, a prima facie case of obviousness is not and cannot be established.

It is noted that a Notice of Appeal fee was previously paid on March 28, 2006. Therefore a new Notice of Appeal fee should not be due.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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26 Nov 2007
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